



31 OCT 2008

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In re Application of	:	DECISION ON
KHABASHESKU et al	:	
PCT No.: PCT/US2005/001310	:	
Application No.: 10/585,591	:	
Int. Filing Date: 18 JAN 2005	:	PAPERS FILED
Priority Date: 21 JAN 2004	:	
Attorney's Docket No.: 11321-PO81WOUS	:	
For: NANOTUBE-AMINO... PREPARING SAME	:	UNDER 37 CFR 1.42

This is a decision on the "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC §371" filed 02 May 2008, which has been treated as a request for status under 37 CFR 1.42.

### **BACKGROUND**

On 11 July 2006, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). Applicants, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration was not provided at such time.

On 20 February 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date" must be submitted within two (2) months from date of mailing of this notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

In response to the Notification mailed on 20 February 2008, applicants filed on 02 May 2008 a declaration signed by Mary Lou Margrave as legal representative of the co-joint inventor now deceased John L. Margrave.

### **DISCUSSION**

A review of the application file reveals that the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because the co-joint inventor John L. Margrave is deceased Mary Lou Margrave has been appointed as the legal representatives for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventor's citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

In this instance the information provided below the signature of the legal representative appears to be that of the legal representative and not of the deceased co-joint inventor. As such, the declaration does not provide the necessary information for the deceased co-joint inventor. Thus, the citizenship, residence and mailing address of the deceased inventor has not been provided in the declaration as required as required under 37 C.F.R. §1.497(b)(2).

Moreover, the declaration is defective since it does not comply with 37 CFR 1.497(a)(3). A declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of two sets of declarations, which one is incomplete since each set must be complete by having the correct number of pages and listing all the inventors. In this case only, one set is complete because it comprises of the four (4) pages of the declaration. The second set is incomplete because it only contains page 4 and does not have the other pages (1, 2 and 3) of the executed declaration. Therefore, the composite declaration is incomplete. In addition, the first set has been labeled as pages 1 of 3, 2 of 3, 3 of 3 and 4 of 4 (the last page), which is inconsistent with respect to proper numbering of the declaration.

Copies of the same page is not part of a proper declaration since it is considered a composite declaration and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

### **CONCLUSION**

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'R. Bacares', is written over the printed name.

Rafael Bacares

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